



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,973	06/20/2000	Arnold M. Lund	USW# 1743	6256

20350 7590 01/23/2007
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

BUI, KIEU OANH T

ART UNIT	PAPER NUMBER
----------	--------------

2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/596,973	Applicant(s) LUND ET AL.	
	Examiner KIEU-OANH BUI	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 21-26 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 21-26, 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal brief filed on 10/16/2006, PROSECUTION IS HEREBY REOPENED. A new office action set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Remark

2. Primary examiner Bui agrees that the previous office action should have been treated as a non-final office action (made and sent out by junior examiner John Manning); and claims 1-10, 21-26, and 33 are now pending for reconsideration.

Response to Arguments

3. Applicant's arguments with respect to claims 1-10, 21-26, and 33 have been considered, but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-10, 21-26, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles et al. (U.S. Patent No. 6,505,348 B1) in view of August et al. (U.S. Patent No. 5,671,267).

Regarding claim 1, Knowles teaches most of the features of claim 1 for an information system comprising a display; a video source sending video to be displayed on the display; a remote control for controlling the displaying on the display including caller identification and a menu for displaying including options for the user to select to display the caller ID information to one or more locations (refer to Figs. 23 to 30 as the viewer can set up whether to turn on or off the displaying of caller ID on the display device or not for telephone services, and the indication of "Select how you want the caller ID pop-up to be displayed" as in Fig. 23 and col. 22/lines 60-67 for displaying on to "any guide screen"; and see col. 4/lines 5-39 for the remote control device which controls the displaying on the display including the caller ID as noted earlier).

Knowles does not further show that the caller ID information is displaying on the remote, wherein the remote including at least a microphone and a speakerphone for telephone communication; however, this technique is taught by August as August teaches that the caller ID information instead of displaying on the display screen (TV screen as shown in Fig. 5 with “MOM 908-555-1234”) and the caller ID information can be set up and provided to the screen on the remote device, i.e., a portable wireless telephone device which including features of a telephone device including a microphone and a speakerphone- refer to Fig. 3—and to Fig. 6 as the caller ID is displayed on the remote device at steps 604-605). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Knowles’ system with August’s feature of transferring caller ID information to a remote communication device for the user/viewer to see the caller ID information on his/her remote communication device at ease while still using the television system to receive both the television and telephone service. The motivation for doing this is to offer a convenience tool as a remote control/handheld communication device for controlling both video and audio service while using the TV system connected to the telephone service (refer to August, col. 1/lines 35-55).

As for claims 3-6, August teaches these features are conventional features of the remote control and the remote control being as a telephone device with infrared communication, microphone, speaker, telephone base unit in wireless communication with the remote and communication of the base unit with a telephone network (August, Figs. 1 & 2 and col. 2/line 27 to col. 3/line 55).

As for claims 7 and 9, Knowles teaches this feature as the video source is a subscription television decoder, i.e., a set top box for receiving video programming or IPG interactive programs (col. 1/line 55 to col. 2/line 3).

As for claims 8 and 10, Knowles teaches this feature wherein the video source is a main unit providing video and telephone communication (refer to Figs. 1A, 1B, 2-8, 18 for a variety of services including video and telephone communication) as well as Internet connection (Fig. 1A, and col. 5/lines 10-20).

As for claims 21-26 and 33, these claims are rejected for the reasons given above, not limited to the cited paragraphs of Knowles and August but also to the entire references, which might teach, disclose and/or inherent suggest any or all of features as cited therein.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles et al. (U.S. Patent 6,505,348 B1) in view of August et al. (U.S. Patent No. 5,671,267) and Markhlouf (U.S. Patent 6,292,172 B1).

As for claim 2, Knowles and August do not suggest the remote device is a wireless keyboard; however, the widely use of a wireless keyboard is known in the art. In fact, Markhlouf teaches of a wireless keyboard as a remote device from the TV or computer set (Figs. 3, 6A, 7A, 17A-C and col. 3/lines 15-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Knowles' system with Markhlouf's feature of a wireless keyboard as a remote device to use with the TV and/or computer monitor set as an enhanced feature to use the keyboard to interface with the TV and/or computer monitor without using any cable or wire.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schindler et al., Gerszberg et al., and Jones (PTO-892 attached) disclose systems related to video and phone communication with the use of a remote control for caller ID displaying.

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to PTO New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller, can be reached at (571) 272-7353.

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Division or Art Unit 2623.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K. Bui', with a long horizontal line extending to the right.

Kieu-Oanh Bui
Primary Examiner
Art Unit 2623

KB
January 20, 2007